

REMARKS

Paragraph [0029] is amended to correct an obvious typographical spelling error.

Claims 1-24 are in the case. Claim 22 is added as a proposed alternative form of claim 1. Claims 23 and 24 are modeled after claim 5.

In the last office action, the examiner rejected independent claim 1 and some of the remaining dependent claims under 35 USC 102 as anticipated by the Hoffman reference. The remaining claims, all dependent, were rejected under 35 USC 103 as unpatentable over the Hoffman reference. Additionally, claims 18-21 were rejected under 35 USC 112 as being indefinite because of applicant's reference to grill structures in claims directed to a tool for use with a grill.

Applicant requested a telephone interview, which was held on April 5, 2005. This greatly assisted applicant's undersigned attorney gain further understanding of the examiner's opinions. Applicant now summarizes the conversation to comply with the requirements of the Office.

The meaning of the word "panel" was discussed. Applicant has retained in this response his comments upon that issue to assure that it will be retained in the record. The examiner agreed that her interpretation of "panel" had been too broad and that the entire box of the Hoffman reference was not a panel. However, she said that she now believed that the word "panel" implied that a panel is flat. She agreed that applicant's claim 1 as stated in the Proposed Amendment submitted before the interview did not read on Hoffman but that she believed that there were other references that were closer. She was concerned that, if a panel is not considered flat, then how much departure is permitted

from flat. She thought that the box of Hoffman could be considered a panel if a panel is not defined as flat. The examiner had no suggestions for claim amendments.

The matter of the references in claim 1 to the grill was also discussed. The examiner said that the problem she sees is not the reference to the grill. The problem is the indefiniteness of the dimensional relationship when referring to the grill because the grill dimensions are not stated and therefore the dimensions of the claimed tool are indefinite. She pointed out that grills come in widely varying sizes.

In view of the interview, applicant has made further amendments to the claims beyond those in the proposed amendment submitted for consideration in the interview. The following remarks include some of the same points discussed in that proposed amendment, but these have been modified and supplemented in view of the comments of the examiner. Applicant sincerely thanks the examiner for the interview.

It is believed that the examiner sees that the invention is quite different from the tray shown in the Hoffman reference, but thinks the claim language doesn't sufficiently distinguish applicant's invention from the Hoffman reference. Applicant's tool for removing food workpieces from a grill is very different from the butler's tray of Hoffman. Applicant is willing to amend the claims to resolve this problem. However, applicant believes there is an error in the examiner's analysis of claim 1 and an error in the analysis of claims 18-21. Applicant also believes that the requirement that a panel be flat is in error and still believes that the 112 rejection, as further explained by the examiner in the interview, is in error.

Applicant will first discuss claim 1, addressing the error that is believed to exist in the examiner's interpretation of the word "panel" and then address the additional limitations to claim 1. Applicant will secondly discuss claims 18-21.

The Word "panel"

The Hoffman reference shows a box A. The examiner interpreted the word "panel" in applicant's claim 1 as "being box A, including inner bottom and longitudinal, lengthwise sides" shown in Hoffman. Applicant respectfully submits that Hoffman's box is not a panel and that interpretation of the word "panel" is inconsistent with its meaning. A panel is a usually flat sheet of material that is relatively thin compared to its length and width.

The examiner seemed to recognize this meaning in paragraph 16 of the last office action. There the examiner said "Hoffman discloses the panel (bottom of box A)". The bottom of box A is a panel. It is a bottom panel. The box also has four side panels attached to the bottom panel and together these five panels make up the box A.

Applicant's attorney looked up the meaning of "panel" on several internet dictionary sites and their definitions are given below. Some irrelevant definitions are omitted. These are directed to such meanings as a group of people (such as a committee or jury panel), a computer window, and an electrical or control panel. Several related or analogous definitions are retained because they convey a similar meaning. These sites provided the following definitions of "panel":

1. One Look Dictionary Search at <http://www.onelook.com/>

“noun: sheet that forms a distinct (usually flat) section or component of something“

2. Merriam-Webster Online Dictionary

1 (inapplicable - directed to groups of persons)
2 : a separate or distinct part of a surface: as a : a fence section : HURDLE b (1) : a thin usually rectangular board set in a frame (as in a door) (2) : a usually sunken or raised section of a surface set off by a margin (3) : a **flat usually rectangular piece of construction material** (as plywood or precast masonry) made to form part of a surface c : a vertical section of fabric (as a gore) d : COMIC STRIP; also : a frame of a comic strip e : any of several units of construction of an airplane wing surface
3 : a thin flat piece of wood on which a picture is painted; also : a painting on such a surface.

3. Cambridge Advanced Learner’s Dictionary

a flat, usually rectangular part, or piece of wood, metal, cloth, etc., that fits into or onto something larger:
a beautiful old door with oak panels.
White silk panels were inset into the sides of the dress.
At the bottom of each page is a panel with grammatical information.

4. Wikipedia

A panel is a thing that blocks one area from another. **It is usually made up of thin sheet metal.**
A panel may be a flat or sculptured area that is part of a larger structure such as a piece of furniture or one element of a multi-panel screen.

All of these definitions, even some of those that apply to other situations (such as a control panel or a dress panel), have in common the fact that a “panel” is a sheet-like piece of material. A panel is principally two-dimensional in the sense that the length and width are considerably larger than the thickness.

The examiner said during the interview that she interpreted the word “panel” as requiring the panel to be flat. The One Look definition shown above has the insertion “(usually flat)”. This necessarily implies that a panel is not always flat. The Wikipedia definition stated above says that “A panel may be a flat or sculptured area”. This necessarily implies that a panel includes alternatives to flat. A panel may depart somewhat from perfectly flat. For example, a dress panel is ordinarily a curved surface when part of a garment but is still referred to as a panel. In other words, a sheet with some curvature or slightly angled regions can still be a panel. Nearly all words used in science and engineering have some vagueness. None are perfect. All that is required is a reasonable degree of definiteness consistent with what is possible.

A patent office definition of panel as found in the class definitions for class 52 says, “*The term panel is used to denote a thin rigid sheetlike structure which may not be disclosed as used repetitiously, e.g., table top or pane.*” This definition says nothing about requiring that a panel be flat. Applicant’s panel is exactly a “*a thin rigid sheetlike structure*”. That is what applicant means by that term. Similarly, class 40 has a subclass with the definition: “*124.07 Having a curved display panel: This subclass is indented under subclass 124.01. Display card wherein the display card includes a display section having a surface deviating from straightness in a generally smooth continuous way.*” Here, the office is using the noun “panel” in reference to a card that deviates from being straight. The word “curved” is additionally used to imply that the panel has a “smooth continuous” deviation. That is one way a panel can deviate from flat. In paragraph [0022] of this application, applicant describes a curved panel as one possible embodiment. This

paragraph demonstrates applicant's use and implicit definition of the term panel consistently with the generally accepted meaning, as explained in this amendment and as his own lexicographer.

From all this discussion of the word "panel" it can be seen that a box is not a panel and a panel can deviate from flat. The examiner has previously seen that a box is not a panel. Applicant has defined his invention in the claims as having a panel and in the specification and some dependent claims has stated how it can deviate from flat.

The Claim 1 Limitations

Although claim 1 is directed to a combination of three component parts, an important part of claim 1, as amended, describes a panel having at least one exposed, longitudinal, open edge, the panel being flat enough and the edge being open and unobstructed enough that the panel is adapted to permit the panel to be slid along the surface and under the workpieces for slidably receiving a row of multiple workpieces. New claim 22 more simply describes the panel as having at least one exposed, longitudinal, unobstructed edge adapted to permit the panel to be slid along the surface and under the workpieces for slidably receiving a row of multiple workpieces. If claim 1 or 22 is compared to Hoffman applying the proper meaning of "panel", Hoffmann shows no such panel. The word "open" means that the edge is not blocked to prevent a workpiece from being slid upon it. The bottom panel has no open edge that can be slid along the support surface and under the workpieces because the bottom panel is blocked by the side panels. The side panels could not be slid under the workpiece because they

are obviously too thick. No one would try to do so. Furthermore, it would not be obvious to modify Hoffman to make it like applicant's invention because the purpose of the Hoffman structure is so completely different from the purpose of applicant's tool. The Hoffman structure is a butler tray and items are placed in a tray by a person picking up an object and manually setting it in the tray. Hoffman is not remotely related to a grill tool or cooking implement for lifting workpieces from a grill and transporting them to another location. A person of ordinary skill in the art would not look to a tray to see how to design a tool to scrape food workpieces from a grill. Carrying trays are non-analogous art. Applicant's tool is designed to be slid along the support surface and under the workpiece supported on that surface.

In view of the above described interview with the examiner, applicant has inserted in claim 1 the limitation "*the panel being flat enough and the edge being open enough that the panel is adapted to permit the panel to be slid along the surface and under the workpieces*".

The portion of the amendment that reads "*adapted to permit the panel to be slid along the surface and under the workpieces*" is not new matter, is not indefinite and is a legitimate distinguishing feature. It is not new matter because it was described in paragraphs [0021], [0024] and [0029] of the specification. The terminology "adapted to" is a recognized, acceptable limitation. See *R.A.C.C. Industries, Inc. v. Stun-Tech, Inc.*, 49 USPQ2d 1793 (Fed. Cir. 1998) and *Ex. Parte Myers*, 7 USPQ 243 (Bd. Patent Appeals 1930).

Although the words “*the panel being flat enough and the edge being open and unobstructed enough*” were not expressed in the application, they are not new matter because this concept is clearly visible from the drawings and clearly inherent and implicit from a reading of the description of the invention and how it operates. The preferred embodiments are shown that way and it would be obvious to any person skilled in the art reading the original application that embodiments of the invention must be formed that way in order to operate in the manner described in the application. MPEP 2163 includes the statements “*While there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.*” “*The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.*” Applicant’s specification and drawings clearly meet that test.

The fact that this is not new matter is also shown by statements of the Court of Appeals for the Federal Circuit in *Wang Laboratories Inc. v. Toshiba Corp.*, (CA FC) 26 USPQ2d 1767. The court said at page 1774”:

“Although [the applicant] does **not** have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed. . . . The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” “A patent specification is directed to one of ordinary skill in the art.”..... “It is also clear that “**drawings alone may provide a 'written description' of an invention as required by Section 112.**”” (emphasis added)

Therefore, since it is clear from the drawings alone, and from the drawings taken with the description of the invention and how it works, that applicant's panel must be "*flat enough and the edge*" must be "*open enough that the panel is adapted to permit the panel to be slid along the surface and under the workpieces*", this limitation is not new matter.

Therefore, in summary, with the word "panel" interpreted to mean a sheet of material and not a box, with the limitation that this panel has "at least one exposed, longitudinal, open and unobstructed edge adapted to permit the panel to be slid along the surface and under the workpieces for slidably receiving a row of multiple workpieces", and with the other two structural components of applicant's combination, the prior art does not teach or make obvious applicant's structural combination.

Claims 18-21 and Their References To The Grill

Dependent claims 18-21 make reference to a support surface which is a grill and refer to the grill in claiming the transfer tool. These claims include limitations relating the tool dimensions to the grill dimensions. They are described in the specification beginning with paragraph [0025]. The examiner stated that "The metes and bounds of the claimed invention, the food transfer tool, are not clearly set forth since the limitations rely on the structure of an unknown item." On this basis the claims were rejected under 35 USC 112.

Applicant is not claiming the grill as an element of the transfer tool. However, applicant is reciting dimensional relationships of the transfer tool to the grill. Applicant is claiming features of the tool that provide a desired relationship to the environment in

which the tool is used. Although the examiner cited Section 112 as the basis for this rejection, the examiner cited no authority for the proposition that a claim can not refer to a relationship between the object being claimed and a surrounding object with which it is used. The examiner cited no authority for the proposition that a claim can not refer to an object that is not part of the claimed invention. Applicant's attorney was unable to find any authority for these propositions.

However, the Court of Appeals For The Federal Circuit has approved exactly that type of limitation. See *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986).

In the *Orthokinetics* case, the relevant portion of the claim stated: "In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof...". The examiner can see that the applicant was claiming a wheel chair but made reference to its relationship to the doorframe and seat of an automobile. In fact the claim made dimensional reference in the sense that the claim recited that the front leg portion of the wheel chair was small enough to be able to be inserted between the seat and the doorframe of the automobile.

Applicant here is doing the same thing. Applicant is relating the size of the transfer tool to the size of a grill.

In the *Orthokinetics* case, under the subheading "(i) Indefiniteness" the court reasoned and concluded:

"A decision on whether a claim is invalid under § 112, Id ¶, requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. Seattle Box Co. v. Industrial Crating & Packing Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984); In re Morasi, 710 F.2d 799, 803, 218 USPQ 289, 292 (Fed. Cir. 1983).

It is undisputed that the claims require that one desiring to build and use a travel chair must measure the space between the selected automobile's doorframe and its seat and then dimension the front legs of the travel chair so they will fit in that particular space in that particular automobile. Orthokinetics' witnesses, who were skilled in the art, testified that such a task is evident from the specification and that one of ordinary skill in the art would easily have been able to determine the appropriate dimensions. The jury had the right to credit that testimony and no reason exists for the district court to have simply discounted that testimony as "conclusory".

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes. See Rosemont, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1547, 221 USPQ 1, 7 (Fed. Cir. 1984). **As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.**

Compliance with the second paragraph of §112 is generally a question of law. Shatterproof Glass Corp. v. Libbey Owens Ford Co., 758 F.2d 613, 619, 225 USPQ 634, 636 (Fed. Cir.), cert. dismissed, 106 S.Ct. 340 (1985). On the record before us, we observe no failure of compliance with the statute, and thus no basis on § 112 grounds for disturbing the jury's verdict." (bold emphasis added)

The MPEP supports the same conclusion. A subtitled paragraph of MPEP 2173.05(e) states:

A CLAIM IS NOT PER SE INDEFINITE IF THE BODY OF THE CLAIM RECITES ADDITIONAL ELEMENTS WHICH DO NOT APPEAR IN THE PREAMBLE

The mere fact that the body of a claim recites additional elements which do not appear in the claim's preamble does not render the claim indefinite under 35 U.S.C. 112, second paragraph. See In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the Larsen claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The examiner

rejected the claim under 35 U.S.C. 112, second paragraph, because the omission from the claim's preamble of a critical element (i.e., a linear member) renders that claim indefinite. The court reversed the examiner's rejection and stated that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, paragraph 2).

In the interview the examiner said that these claims are indefinite because grills come in different sizes and therefore it is impossible to tell what would be 50% or 80% of the grill width. The examiner (who had not had an opportunity to read the *Orthokinetics* case) also said that car sizes are uniform. But the court, in the *Orthokinetics* case quoted above, spoke to and rejected the argument that the examiner spontaneously stated. As can be seen in the above quote, the court said that automobiles come in different sizes and it doesn't matter that the invention may fit in some but not in others. The court said that the phrase "*"so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes*". The court said "*As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more.*" All these observations made by the court with respect to a travel wheel chair claimed in relationship to the space between an automobile door frame and seat are equally true of the relationship between the length of applicant's tool and the width of the grill it is used on.

Therefore, it is respectfully submitted that the rejection under 35 U.S.C. 112 should be withdrawn.

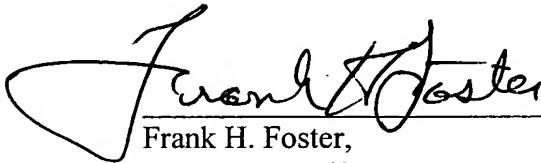
Conclusion

Applicant therefore respectfully submits that the claim limitations in the claims as amended distinguishes applicant's transfer tool from Hoffman's tray. Additionally, applicant's reference to the grill in claims 18-21 are proper and not indefinite under 35 USC 112. Therefore, reconsideration and allowance are respectfully requested.

The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,

5/10/05
Date of Signature



Frank H. Foster,
Reg. No. 24,560
KREMLAS, FOSTER, PHILLIPS & POLLICK
7632 Slate Ridge Blvd.
Reynoldsburg, OH 43068
Voice: 614/575-2100
Fax: 614/575-2149
email: ffoster@ohiopatent.com

Enclosures: Request for RCE form
Fee Transmittal Form
Claim Determination Record
Check in the amount of \$1010.00
Return receipt postcard
Extension of Time Request

Last printed 5/10/2005 12:25 PM
I:\client.docs\w\wendy's intl., inc\208 transfer tool\response2.doc